

Application No.: 10/714,250
Applicant: DOHAN
Filed: November 14, 2003
Page 5 of 12

Remarks

Introduction

Claims 1-20 were pending. By way of this response, claims 1 and 13 have been amended. Claim 1 has been amended to include subject matter from claims 13, 14 and 19, and claim 13 has been amended to comport with the amendments to claim 1. Applicant submits that the amendments and remarks included herein show the present claims to be allowable and do not raise new issues. Therefore, Applicant respectfully requests that this amendment be entered. Accordingly, claims 1-20 remain pending.

Rejection Under 35 U.S.C. § 102

Claims 1-3, 16, and 18-20 remain rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Relyea (U.S. Patent No. 4,594,276).

Applicant respectfully traverses the rejection as originally presented, and as it applies to the present claims. As indicated above, claim 1 has been amended to include subject matter from claim 13, which is indicated as not being anticipated by Relyea.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." (Emphasis added; *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). An anticipating reference must describe the patented subject matter with sufficient clarity and detail to establish that the subject matter existed and that its existence was recognized by persons of ordinary skill in the art (*ATD Corp. v. Lydall, Inc.*, 48 USPQ 2d 1321, 1328 (Fed. Cir. 1998)).

Relyea discloses removable temporary body tattoos which appear similar to real body tattoos (col. 2, lines 18-20). The images of the tattoos of Relyea blend naturally with the skin (col. 2, lines 14-15). The tattoos disclosed by Relyea are made of an inextensible (i.e., non-elastic or

Application No.: 10/714,250
Applicant: DOHAN
Filed: November 14, 2003
Page 6 of 12

non-stretchable) surgical tape having a non-adhesive surface and one adhesive surface (col. 2, line 66 to col. 3, line 4) and include an image on the non-adhesive surface of the surgical tape. The surgical tape tattoos disclosed by Relyea blend with the skin to provide a real body tattoo appearance (col. 4, lines 37-39). In short, Relyea discloses a temporary tattoo which has a negligible thickness and which is formed with inextensible surgical tape having one non-adhesive surface and one adhesive surface, the non-adhesive surface has an image located thereon.

Applicant maintains that Relyea does not disclose, teach, or suggest the present invention, as stated in Applicant's previous response, and for the reasons that follow. For example, Relyea does not disclose, teach, or even suggest reusable adhesive body apparel that comprises an adhesive component formed of a material that enables the apparel to adhere to a body surface at least one additional time after removal therefrom, as recited in claim 1, and the claims dependent therefrom. In other words, Relyea does not disclose, teach, or even suggest adhesive body apparel that is reusable.

The Examiner has repeated her remarks that column 2, line 1 to column 3, line 58, and column 4, lines 32-39 discloses apparel having an uneven surface topography, wherein the medical grade tape material used is reusable and is removable without pain to the wearer and with the adhesive laminated to the tape material.

Applicant has extensively reviewed Relyea, and respectfully disagrees that the reference discloses a material that is reusable. In addition, Applicant has conducted a computerized text search of Relyea, and submits that Relyea does not even include the word "reusable". At best, Relyea discloses that the tattoo can be removed. Applicant's undersigned representative has left messages for the Examiner (Examiner Hale) on October 11, 2004 and October 19, 2004 requesting clarification where Relyea discloses reusable material. The undersigned has not received a return call from the Examiner.

Application No.: 10/714,250
Applicant: DOHAN
Filed: November 14, 2003
Page 7 of 12

Applicant maintains that the adhesive specifically disclosed by Relyea is not reusable. Applicant notes that although Relyea discloses the acrylic adhesives are preferred, Relyea does not disclose any other specific type of adhesive which can be used with the tattoo. Applicant submits that a person of ordinary skill in the art must reasonably conclude based on the teachings of Relyea that the adhesives used on the surgical tape are acrylic adhesives, or adhesives with similar properties, such as being removable but not reusable. Applicant maintains that the adhesives of Relyea's tattoos do not permit the tattoo to be removed and reused, as suggested by the Examiner. To the extent that the Examiner maintains the position that Relyea discloses reusable tattoos, Applicant requests the Examiner to specifically indicate which column and line of Relyea indicates that the tattoos are reusable.

In addition, claim 1 has been amended as set forth above. Claim 1 has been amended to indicate that the decorative component of the apparel is stretchable and has a non-adhesive surface and an adhesive surface (which was included in claim 13), and that the adhesive component of the apparel is coupled to the adhesive surface of the decorative component. In other words, the apparel of the present claims is stretchable and includes more than one adhesive portion, e.g., the presently claimed apparel has an adhesive component which is coupled to an adhesive surface of the decorative component.

Applicant submits that Relyea does not disclose, teach, or even suggest a tattoo which is stretchable and includes more than one adhesive portion. As discussed above, the tattoo disclosed by Relyea is inextensible and includes only one adhesive surface, i.e., the adhesive surface of surgical tape.

Furthermore, claim 1 has been amended to provide a stipulation as to the conditions of usage, as suggested by the Examiner. For example, claim 1 has been amended to indicate that the apparel can be reused or reapplied without substantial modifications to the apparel. Applicant submits that the tattoos disclosed by Relyea do not include an adhesive which is effective in permitting the tattoos to be reused, let alone to be reused without substantial modifications to the apparel.

Application No.: 10/714,250
Applicant: DOHAN
Filed: November 14, 2003
Page 8 of 12

In view of the above, Applicant submits that Relyea does not teach each and every limitation recited in the present claims, and therefore, the present claims, and claims 1-3, 16, and 18-20 in particular, are not anticipated by Relyea under 35 U.S.C. § 102. In addition, Applicant submits the present claims are unobvious from and patentable over Relyea under 35 U.S.C. § 103.

Rejections Under 35 U.S.C. § 103

Claim 4 remains rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Relyea in view of Felton et al. (U.S. Patent No. 6,207,874). Claims 5 and 17 remain rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Relyea in view of Limburg et al. (U.S. 6,604,854). Claims 6, 7, 12, 14, and 15 remain rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Relyea in view of Applicant's Own Disclosure of Known Adhesives. Claims 8-11 remain rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Relyea in view of Dodge (U.S. Patent No. 6,371,831). Claim 13 remain rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Relyea in view of Dodge and Applicant's Own Disclosure of Known Adhesives.

Applicant respectfully traverses the rejections as originally presented, and as they relate to the amended claims. As discussed above, claim 1 has been amended to include subject matter recited in claims 13, 14, and 19.

Applicant maintains that the Examiner has failed to establish a *prima facie* case of obviousness. For example, the Office Action fails to indicate where in the prior art, a suggestion or motivation is provided to modify the teachings of references to obtain the claimed apparel. Absent such an indication, Applicant submits that the rejections under 35 U.S.C. § 103 cannot be maintained. The motivation or suggestion to support a rejection under 35 U.S.C. § 103 must be clear and particular (*In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999); emphasis added), and "particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination

Application No.: 10/714,250
Applicant: DOHAN
Filed: November 14, 2003
Page 9 of 12

in the manner claimed" (*In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000)).

Applicant submits that a person of ordinary skill in the art would not be motivated to combine the references, and even if the references were to be erroneously combined, Applicant submits that the combination of references to do not teach each and every limitation recited in the present claims. Therefore, Applicant submits that a *prima facie* case of obviousness has not been established.

Relyea is discussed above.

Felton et al. discloses temporary tattoos for aesthetic and reconstructive purposes. The tattoo disclosed by Felton et al. includes only one adhesive portion 74 (col. 4, line 45). The tattoo includes an image located on a non-adhesive material. Felton et al. does not disclose a tattoo that is reusable.

Limburg et al. discloses a thin film thermometer which comprises a single adhesive portion (col. 6, lines 56-63; and col. 7, line 32). The thermometer includes an image on a non-adhesive material. Limburg et al. does not disclose a thermometer film that is reusable.

Dodge discloses a strapless swimsuit top. The swimsuit top includes a single adhesive attached to a fabric (col. 2, lines 26-27; col. 3, lines 58-59). Dodge does not disclose that the swimsuit top is reusable.

Since claim 1 has been amended to include subject matter from claim 13, and since claim 13 was only rejected over the combination of Relyea, Dodge, and Applicant's own disclosure, Applicant submits the rejections under 35 U.S.C. § 103 of claims 4-12, 14, 15, and 17, which are dependent from claim 1, are moot.

Application No.: 10/714,250
Applicant: DOHAN
Filed: November 14, 2003
Page 10 of 12

Applicant submits that the present claims, including claim 1, are unobvious from and patentable over the combination of Relyea, Dodge, and Applicant's own disclosure under 35 U.S.C. § 103.

For example, Applicant submits that a person of ordinary skill in the art would not be motivated to combine the teachings of Relyea, Dodge, and Applicant's own disclosure. As discussed above, Relyea's tattoos have almost no thickness, for example, the tattoos appear to blend with the skin to provide the appearance of a real body tattoo (col. 2, line 20; col. 2, lines 42-43; and col. 4, lines 37-39). Applicant does not concede that Applicant's own disclosure of conventional hydrogels is prior art to the above-identified application, and Applicant submits that a person of ordinary skill in the art would not be motivated to use a hydrogel instead of the adhesive of Relyea's tattoos. Hydrogels used in conventional patches have a thickness such that the patch includes a surface visually spaced apart from a skin surface. As discussed above, Relyea discloses tattoos of almost no thickness. Applicant submits that a person of ordinary skill in the art would not be motivated to substitute the adhesive of the tattoos disclosed by Relyea with a hydrogel because such a tattoo would no longer blend well with the skin and provide the appearance of a real body tattoo, as specifically taught by Relyea (e.g., col. 2, lines 14-21; col. 2, lines 42-43; and col. 4, lines 37-39). Thus, Applicant maintains that Relyea actually teaches away from the use of adhesives which have more than a nominal thickness, and therefore a person of ordinary skill in the art would not be motivated to substitute a hydrogel with the adhesive of the tattoos disclosed by Relyea. "As a general rule, references that teach away cannot serve to create a prima facie case of obviousness." (*McGinley v. Franklin Sports, Inc.* CAFC 8/21/01 citing *In re Gurley*, 31 USPQ2d 1131, (Fed. Cir. 1994)).

In addition, Applicant submits that even if the references and Applicant's own disclosure were to be erroneously combined, the combination fails to disclose each and every limitation recited in the present claims. For example, the combination of references fail to disclose, teach, or even suggest reusable adhesive body apparel comprising an adhesive component formed of a material that enables the apparel to adhere to a body surface at least one additional time after removal the body surface, as recited in the present claims.

Application No.: 10/714,250
Applicant: DOHAN
Filed: November 14, 2003
Page 11 of 12

The combination of references also fail to disclose, teach, or even suggest reusable adhesive body apparel which comprises a stretchable decorative component. As discussed above, the primary reference, Relyea, specifically states that the temporary tattoo is inextensible (col. 3, lines 2-3). Inextensible means non-elastic or non-stretchable. Thus, applicant submits that Relyea actually teaches away from reusable adhesive body apparel that comprise a stretchable decorative component, as recited in the present claims. As stated above, a reference that teaches away cannot serve to create a *prima facie* case of obviousness. Therefore, the combination of references do not make obvious the presently claimed invention.

Furthermore, the combination proposed by the Examiner fails to disclose, teach, or even suggest apparel which comprises more than one adhesive portion, as recited in the present claims. As discussed above, each of the references specifically discloses articles comprising only one, or a single, adhesive layer. The present claims are directed to apparel that comprises a stretchable decorative component, which comprises an adhesive surface; and an adhesive component that is coupled to the adhesive surface of the decorative component. In other words, the apparel of the present claims includes more than one adhesive portion, and is stretchable. As discussed above, the combination of references do not disclose, teach, or even suggest more than one adhesive portion in an article, let alone the apparel recited in the present claims.

Moreover, Applicant submits that the combination of references actually teaches away from apparel having more than one adhesive portion because increasing the number of adhesive portions or layers in the articles of the cited references results in an increase in the thickness of the articles. As discussed above, the primary reference, Relyea, is directed to tattoos which have substantially no thickness so that the tattoos are visually similar to real body tattoos and blend well with the skin. Thus, Applicant submits that a person of ordinary skill in the art would not be motivated to combine the cited references, including Relyea and Dodge, with Applicant's own disclosure, and even if they were erroneously combined, the combination fails to disclose, teach, or even suggest all of the limitations of the present claims.

Application No.: 10/714,250
Applicant: DOHAN
Filed: November 14, 2003
Page 12 of 12

In view of the above, Applicant submits that the present claims, and claims 1-20 in particular, which are directed to reusable adhesive body apparel that comprises a stretchable decorative component and has more than one adhesive portion, such as the adhesive surface of the decorative component, and the adhesive component of the apparel coupled thereto, are unobvious from and patentable over the combination of references under 35 U.S.C. § 103.

Conclusion

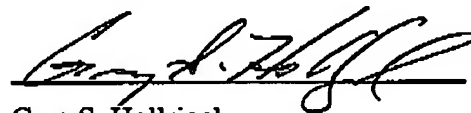
In conclusion, Applicant has shown that the present claims are not anticipated by and are unobvious from and patentable over the prior art under 35 U.S.C. §§ 102 and 103. Therefore, Applicant submits that the present claims, that is claims 1-20 are in condition for allowance. Accordingly, Applicant requests the Examiner to pass the above-identified application to issuance at an early date.

If a telephone interview would be of assistance in advancing prosecution of the subject application, Applicant's undersigned representative invites the Examiner to telephone him at the number provided below.

Respectfully submitted,

Date: _____

10/21/04



Greg S. Hollrigel
Registration No. 45,374
Stout, Uxa, Buyan & Mullins, LLP
4 Venture, Suite 300
Irvine, California 92618
Telephone: 949-450-1750